REMARKS

This Response responds to the Office Action dated May 11, 2010 in which the Examiner rejected claims 1-2, 4-6, and 8-20 under 35 U.S.C. § 103.

Claims 1 and 11 claim an input method and claims 5 and 12 claim a touch panel input apparatus. The method and apparatus include a touch panel laminated onto a display screen of a display apparatus. A sensor unit is formed so as to be expanded to an outside of one side of the display screen. An instruction, according to a touching position of a finger or touch pen onto the sensor unit, is given. A controller generates a control signal based on the instruction. A selection display is displayed when the finger or touch pad is initially touched and remains in contact with the sensor unit. A selection item is highlighted when the finger or touch pen is near the selection item as the finger or touch pen remains in contact with the sensor unit after the initial touch and is moved along the sensor unit. The highlighted selection item is selected upon lifting the finger or touch pen from contact with the sensor unit near the highlighted selection item after being moved along the sensor unit. A selection display is cancelled when the finger or the touch pen remains in contact while being moved from the sensor unit to the display screen on the touch panel. A single touch, move/slide and release contact operation of the finger or touch pen with the sensor unit executes a combined operation (a) to display the selection display and (b) to select a desired selection item in the selection display.

By having a single touch, move/slide and release contact operation of the finger or touch pen with the sensor unit which executes a combined operation (a) to display a selection display and (b) to select a desired selection item in the selection display, as claimed in claims 1, 5, 11 and 12, the claimed invention provides an input method and apparatus which can cancel an operation or select an operation with a single touch, move/slide and release contact operation

with the display screen. The prior art does not show, teach or suggest the invention as claimed in claims 1, 5, 11 and 12.

Claims 1-2, 4-6 and 8-20 were rejected under 35 U.S.C. § 103 as being unpatentable over *Beernink, et al.* (U.S. Patent No. 5,434,929) in view of *Nishibori* (U.S. Patent No. 5,977,948).

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

Beernink, et al. appears to disclose text recognition in pen-based computer systems (column 1, lines 9-10). When operating has an input device, the display assembly senses the position of the tip of a stylist on the viewing screen and provides this positional information to the computer central processing unit (CPU) (column 1, lines 34-37). Graphical images can be input into the pen-based computer by merely moving the stylist on the surface of the screen. As the CPU senses the position and movement of the stylist, it generates a corresponding image on the screen to create the illusion that the stylist is drawing the image directly on the screen, *i.e.* that the stylist is "inking" an image on the screen (column 1, lines 45-52). A "pseudo" keypad 24' comprises "button" areas which are associated with a bottom edge of a tablet membrane that extends beyond the lower edge of the LCD display (column 4, lines 36-39). When the "buttons" are selected by engaging the stylist 38 with the membrane over these printed icons, the membrane senses the pressure and communicates that fact to the CPU 12 via data bus 37 and I/O (column 4, lines 42-45). In Figure 2b, the screen 52 of Figure 2a is illustrated with an open preferenee window 72. This window is activated by first selecting the Extras button 74 of the pseudo keyboard 24' to open a pop-up window of command icons and then subsequently

selecting a Preferences icon. Selection in this instance refers to "tapping" the button icon or menu listing. A tap gesture involves placing the stylist 38 on the screen 52 for a short, predetermined length of time and then lifting the stylist without moving the stylist a significant amount. Placing the stylist on the screen for a period of less than in the range of one twentieth to one seconds may be appropriate, with one third of a second being an appropriate maximum hold period. Also, to qualify as a tap gesture, the stylist must not have been moved more than an insignificant distance across the screen. By weigh of example, movement of more than in the range of two to ten pixels may be considered enough to disqualify an input from being a tap gesture (column 7, lines 37-59, emphasis added).

Thus, *Beernink, et al.* merely discloses selecting an item by tapping (*i.e.* touch and release). Nothing in *Beernink, et al.* shows, teaches or suggests (1) displaying a selection display when a finger or touch pen is initially touched and remains in contact with a sensor unit and (2) a combined operation to display a selection display and to select a desired selection item in the selection display are executed by a single touch, move/slide and release contact operation of the finger or touch pen with the sensor unit as claimed in claims 1, 5, 11 and 12. Rather, *Beernink, et al.* only discloses selecting an item by tapping (*i.e.* touch and release for a short predetermined length of time and then lifting the stylist without moving the stylist a significant amount).

Furthermore, *Beernink, et al.* merely discloses by sensing position and movement of a stylist, a CPU generates a corresponding image on a screen to create the illusion that the stylist is drawing the image directly on the screen. Thus, nothing in *Beernink, et al.* shows, teaches or suggests selecting a highlighted selection item upon lifting a finger or touch pen from contact with the sensor unit at the position of the highlighted selection item after being moved along a side of the sensor unit as claimed in claims 1, 5, 11 and 12. Rather, *Beernink, et al.* merely

discloses that when the stylist is moved on the screen, a CPU generates a corresponding image on the screen to create the illusion that the stylist is drawing the image directly on the screen. In other words, any movement in *Beernink, et al.* is associated with drawing an image, which teaches away from the claimed invention.

Nishibori appears to disclose in Figure 11 a first hierarchal menu 41 which is the very top hierarchy. The cursor is shifted while pressing the mouse button while the cursor is positioned on the menu item "recognize". When the menu item "recognize" is pointed by the cursor, a second hierarchy menu 42 which is the one level lower hierarchy which can be displayed automatically as shown in Figure 12. Further, the cursor is moved to the second hierarchy menu 42 while pressing the mouse. In the second hierarchy menu 42, with the mouse in the pressed condition, the cursor is shifted to the position of a menu item "scratch". Then, as shown in Figure 13, the third hierarchy menu 42 will be displayed. In the same way, by moving the cursor to the menu item "see" in the third hierarchy menu 43, the fourth hierarchy menu 44 will be displayed as shown in Figure 14. Figure 15 shows the situation in which the cursor points out the word "seeing" in the fourth hierarchy menu 44. Here, if the mouse button is released, the menu item "seeing" which the cursor is now positioned will be considered to be the character for input. Besides, if the cursor is moved to the fifth hierarchy menu 45 and released at the position of the menu item "seeing" input processing of "seeing" can also be executed. In the fifth hierarchy menu 45, "Seeing" or "SEEING" can be selecting for input. When the cursor is moved from the lower hierarchy menu to the higher hierarchy menu, the lowest hierarchy menu which is displayed may be closed. If no input processing of character is to be made, by moving the cursor away from all the menus and releasing the mouse button, the whole menus will be closed and input processing will end (column 7, lines 18-57).

Thus, *Nishibori* merely discloses a virtual cursor operated via a mouse. Nothing in *Nishibori* shows, teaches or suggests (a) a touch panel input apparatus which is touched by a finger or touch pen or (b) executing a combined operation to display a selection display and to select a desired selection item in the selection display by a single touch, move/slide and release contact operation of a finger or touch pen with a sensor unit as claimed in claims 1, 5 and 11-12. Rather, *Nishibori* merely discloses a virtual sensor operated via a mouse.

Furthermore, *Nishibori* only discloses moving a virtual cursor via a mouse in order to successively pop up hierarchy menus. Nothing in *Nishibori* shows, teaches or suggests (1) displaying a selection display when a finger or touch pen is initially touched and remains in contact with a sensor unit, (2) a combined operation to display a selection display and to select a desired selection item in the selection display are executed by a single touch, move/slide and release contact operation of a finger or touch pen with a sensor unit of a touch panel and (3) selecting a highlighted selection item upon lifting the finger or touch pen from contact with the sensor unit at the position of the highlighted selection item after being moved along the side on the sensor unit as claimed in claims 1, 5, 11 and 12. Rather, *Nishibori* only discloses moving a virtual cursor via a mouse in order to automatically display lower level hierarchy menus.

Applicants respectfully submit that the Examiner is using hindsight to combine *Beernink, et al.* and *Nishibori*. As stated in the Court of Appeals for the Federal Circuit in *Gore v. Garlock*, 220 USPQ 330, 312-313 (CAFC, 1983), cert. denied 486 U.S. 851: "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

Applicants respectfully submit that the combination of *Beernink, et al.* and *Nishibori* is not possible since *Beernink, et al.* clearly teaches any movement would cause drawing of a figure on the screen and only tapping is used to select an item. Furthermore, the technologies of *Beernink, et al.* using a touch pen for tapping and writing on a screen is completely different from a virtual cursor moved by a mouse as taught by *Nishibori*. Applicants respectfully submit that the Examiner is only selecting bits and pieces of the references without considering the remaining teachings of those references which would lead away from the claimed invention. As the Courts have stated in *In re Wesslaw*, 147 USPQ 391, 393 (CCPA, 1963) quoted with approval in *In re Hedger*, 228 USPQ 685, 687 (CAFC, February 1986) "It is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of the other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." Nowhere in *Beernink, et al.* and *Nishibori* is it shown, taught or suggested to combine the references as suggested by the Examiner.

A combination of *Beernink, et al.* and *Nishibori* would not be possible since any movement of the stylist 38 of *Beernink, et al.* would correspond to drawing an image on a screen. Furthermore, *Nishibori* uses a virtual cursor moved via a mouse and is unrelated to a touch panel input apparatus. Thus, a combination of the references is not possible. Even assuming arguendo that the references can be combined, the combination would merely suggest to select an item using a tap as taught by *Beernink, et al.* and in combination with a mouse to have automatic display of lower hierarchy menus while pressing the mouse button as taught by *Nishibori*. Thus, nothing in the combination of the references shows, teaches or suggests (1) displaying a selection display when a finger or touch pen is initially touched and remains in contact with a sensor unit,

(2) a combined operation to display a selection display and to select a desired selection item in the selection display are executed by a single touch, move/slide and release contact operation of a finger or touch pen with a sensor unit of a touch panel and (3) selecting a highlighted selection item upon lifting the finger or touch pen from contact with the sensor unit at the position of the highlighted selection item after being moved along the side on the sensor unit as claimed in claims 1, 5, 11 and 12. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 1, 5, 11 and 12 under 35 U.S.C. § 103.

Claims 2, 4, 6, 8-10 and 13-20 recite additional features. Applicants respectfully submit that claims 2, 4, 6, 8-10 and 13-20 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Beernink, et al.,* and *Nishibori* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 2, 4, 6, 8-10 and 13-20 under 35 U.S.C. § 103.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.

CONCLUSION

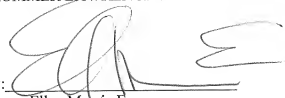
If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP



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